

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIUBO HONG, RONALD A. BARR
and DASHUN STEVE ZHOU

Appeal No. 2003-0323
Application 09/268,088

ON BRIEF

Before KIMLIN, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in appellants' brief and reply brief, and based on our review, find that we cannot sustain the rejection of claims 1 through 14, 23 through 25, 27 through 29, and 31, as amended after final rejection, which are all of the claims remaining in this application.¹

The references relied on by the examiner as evidence of obviousness are:

Desserre	4,771,350	September 13, 1988
Cohen et al. (Cohen)	5,703,740	December 30, 1997
Dill, Jr. et al. (Dill)	6,226,149	May 1, 2001

¹ Claim 26 was cancelled in the amendment after final dated April 17, 2002, which was entered as per the Advisory Action mailed April 23, 2002.

Claims 1 through 5, 10 through 14, 23 through 25, and 27 through 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Dill. Claims 6 through 9 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen and Dill in view of Desserre. We reverse these rejections.

Opinion

We agree that the Cohen reference, modified in the manner proposed by the examiner, would meet each element of appealed claim 1. However, in order to establish that the claimed invention would have been obvious to a person of ordinary skill in the art at the time of the invention within the meaning of 35 U.S.C. § 103(a), the examiner must show some objective teaching, suggestion or motivation in the applied prior art or knowledge generally available to one of ordinary skill in the art that would have led that person to combine the teachings. *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784-85.

The examiner acknowledges that Cohen does not teach the conductor winding **32B** being formed in a trench etched from a conductor insulation layer **25**. (Answer, page 4.) The examiner takes the position that a person of ordinary skill in the art would have been motivated to combine Cohen and Dill “to make the top surfaces of the coil and the conductor insulation layers share a common flat top surface in order to be better prepared for subsequent construction” (*Id.*) Appellants argue that the benefit of a common flat surface as taught by Dill does not translate to the proposed modified structure of Cohen. Specifically, appellants contend that Cohen already produces a planarized organic insulation layer and that there is, therefore, no need to substitute the planarized inorganic layer of Dill for the planarized organic layer of Cohen. (Reply Brief, page 3.)

We are in agreement with appellants that a desire to form a common flat surface would not have provided the requisite motivation for one of ordinary skill in the art to combine Cohen

and Dill in the manner suggested by the examiner. We find that Cohen teaches using organic insulation layers for planarization (Cohen, col. 16, ll. 64-65) and that the insulation layers between the bottom magnetic yoke arm **20** and the top magnetic yoke arm **28** are all organic insulation layers (Cohen, col. 18, ll. 40-44). We do not see how the planarized inorganic coil insulation layer **216** of Dill would be beneficial relative to the planarized organic insulating layers already present in Cohen for forming subsequent coil layers. Indeed, in **Fig. 2**, Cohen teaches forming another coil layer **36A** on top of the planarized insulation layer **25**, while Dill teaches no such additional coil layers. The examiner points to a passage in Dill stating that the common flat surface of the second pole tip **318**, the coil layer **330** and the write coil insulation layer **332** form a common flat surface that is important for subsequent construction of the second pole piece. (Dill, col. 9, ll. 53-57.) However, this statement does not provide motivation to substitute the inorganic write coil insulation layer of Dill for the organic insulation layer in a write head that uses a single upper pole layer such as Cohen. We find that the examiner has failed to establish that a person of ordinary skill in the art would have been motivated to replace the organic insulation layer **37** and winding **32B** of Cohen with the inorganic coil insulation layer **216** of Dill. *See In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1459 (“hindsight” is inferred when there is no explanation of the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one without knowledge of the claimed invention to make the combination). Accordingly, we reverse the grounds of rejection advanced on appeal because the examiner has not established a *prima facie* case of obviousness of the thin film write head structure encompassed by the appealed claims.

We note that Desserre, relied upon by the examiner in the rejection of claims 6 through 9 and 31, does not remedy the deficiency discussed above with regard to the combination of Cohen and Dill.

The examiner's decision is reversed

REVERSED

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

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